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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,258	06/26/2001	Tadashi Ezaki	SONYJP-131	2603

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EXAMINER
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CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/869,258	EZAKI, TADASHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	David G. Cervetti	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 41-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-40 are pending and have been examined. Claims 41-63 were withdrawn as response to a Requirement for Restriction/ Election mailed by this Office on 1/24/2006.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: "FFE" (page 5), "MDCR" (page 10). These terms have not been defined. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 2, 4-6, 8, 10-18, 20, 22-24, 26, 28-36, 38, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors ("output of said contents is to record said contents on a recording medium", claim 2, "threshold is contained in advance in said", claim 10, and "the information is the information for defining a data compression method in outputting said contents", claim 6).

Claims 11 and 29 recite the limitation "digital watermark information strong/weak to compression". There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 37-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 37 states "a program storage medium for supplying a program to an information processing device, said program comprising a step of...and a step of...".

These limitations are considered non-statutory subject matter because they consist of a program per se, not executable instructions. The claims are not limited to tangible embodiments.

Claims 38-40 are rejected based on its dependency from claim 37.

7. To expedite a complete examination of the application, the claims rejected under 35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawara et al. (US Patent 6,278,836, hereinafter Kawara).**

Regarding claims 1, 19, and 37, Kawara teaches detecting digital watermark information distributed associated with said contents; and controlling the output of said contents on the basis of said digital watermark information (column 10, lines 30-67). Kawara does not expressly disclose detecting the survival rate of the digital watermark. However, Kawara provides "auxiliary information for controlling reproduction of main information" (column 10, lines 35-48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in that "auxiliary information" information that may help in order to control reproduction. One of ordinary skill in the art would have been motivated to perform such a modification because it was well known in the art to use auxiliary information to provide copyright protection (Kawara, column 13, line 50 to column 14, line 45).

Regarding claims 2, 20, and 38, Kawara teaches characterized in that the output of said contents is to record said contents on a recording medium (column 35, lines 27-61).

**Regarding claims 3, 21, and 39,** Kawara teaches characterized in that said digital watermark information contains first control information indicating whether or not to output the contents, and second control information indicating whether or not to output the contents when said survival rate is less than or equal to a predetermined threshold, said digital watermark information detection section detects said first and second control information, and said control section controls the output of said contents on the basis of said first and second control information (column 13, line 50 to column 14, line 45).

**Regarding claims 4, 22, and 40,** Kawara teaches characterized in that said digital watermark information contains qualified information in outputting said contents, said digital watermark information detection section detects said qualified information, and said control section controls the output of said contents on the basis of said qualified information (column 13, line 50 to column 14, line 45).

**Regarding claims 5 and 23,** Kawara teaches characterized in that said qualified information is the information for restricting the quality in outputting said contents (column 17, lines 30-67, column 18, lines 1-9).

**Regarding claims 7 and 25,** Kawara teaches characterized in that said control section inhibits the output of said contents when said survival rate is less than or equal to a predetermined threshold (column 13, line 50 to column 14, line 45).

**Regarding claims 9 and 27,** Kawara teaches characterized in that said control section restricts the output of said contents on the basis of said qualified information

when said survival rate is less than or equal to a predetermined threshold (column 13, line 50 to column 14, line 45).

**Regarding claims 8, 10, 26, and 28,** Kawara teaches characterized in that said threshold is contained in advance in said digital watermark information (column 13, line 50 to column 14, line 45).

**Regarding claims 11, 15, 29, and 33,** Kawara is mute regarding digital watermarks strong/weak to compression. However, Examiner takes Official Notice that the use of such watermarks was conventional and well known at the time the invention was made. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such watermarks since Examiner takes Official Notice that it was conventional and well known.

**Regarding claims 12 and 30,** Kawara teaches characterized in that said digital watermark information strong to compression contains the qualified information in outputting said contents, said digital watermark information detection section detects said qualified information, and said control section controls the output of said contents on the basis of said qualified information (column 13, line 50 to column 14, line 45).

**Regarding claims 13 and 31,** Kawara teaches characterized in that said qualified information is the information for restricting the quality in outputting said contents (column 17, lines 30-67, column 18, lines 1-9).

**Regarding claims 6, 14, 24, and 32,** Kawara teaches characterized in that said qualified information is the information for defining a data compression method in outputting said contents (column 10, lines 35-48).

**Regarding claims 17 and 35,** Kawara teaches characterized in that said control section restricts the output of said contents on the basis of said qualified information when said survival rate is less than or equal to a predetermined threshold (column 13, line 50 to column 14, line 45).

**Regarding claims 16, 18, 34, and 36,** Kawara teaches characterized in that said threshold is contained in advance in said digital watermark information strong to compression (column 13, line 50 to column 14, line 45).



**Conclusion**


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mitui et al. (US Patent 6,937,553) teach restricting quality of recorded contents, Cox et al. (US Patent 6,154,571) teach using robust watermarking.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DGC

  
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